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HARRITY SNYDER, LLP 11350 Random Hills Road SUITE 600 FAIRFAX, VA 22030			COBY, FRANTZ	
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**BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES**

Application Number: 09/734,886  
Filing Date: December 13, 2000  
Appellant(s): HOELZLE ET AL.

**MAILED**

OCT 02 2006

**Technology Center 2100**

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John E. Harrity  
For Appellant

**EXAMINER'S ANSWER**

This is in response to the appeal brief filed July 18, 2006 appealing from the Office action mailed February 21, 2006.

**(1) Real Party in Interest**

A statement identifying by name the real party in interest is contained in the brief.

**(2) Related Appeals and Interferences**

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

**(3) Status of Claims**

The statement of the status of claims contained in the brief is correct.

**(4) Status of Amendments After Final**

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

**(5) Summary of Claimed Subject Matter**

The summary of claimed subject matter contained in the brief is correct.

**(6) Grounds of Rejection to be Reviewed on Appeal**

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

**(7) Claims Appendix**

The copy of the appealed claims contained in the Appendix to the brief is correct.

**(8) Evidence Relied Upon**

6,112,202                    KLEINBERG                    08-2000

**(9) Grounds of Rejection**

The following ground(s) of rejection are applicable to the appealed claims:

***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-6 and 9-24 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter that was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The phrase: "search object" is not defined in the specification, and its relationship to highlighted characters is not set forth in an enabling manner. In the Brief, page 14 top, it is stated that the search object may or may not be dependent on the highlighted characters (of the claims), which leaves it to be anything.

Reference is made to page 12 of the Specification, where it is stated that a user may select a software button or menu item provided, perhaps, by a browser assistant. The term search object is not used in this discussion, and thus the connection of a browser assistant and/or buttons and menus to such a term is not made. Furthermore, these terms do not appear in the claims.

Claim 2 states that the search object may be located in a menu or toolbar, but does not explicate what it is per se, and the claim is not part of the Specification. In summary, there is no viable guidance in the Specification to enable one skilled in the art to make and/or use the invention as claimed using this phrase.

Claims 1-6 and 9-24 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

It is not clear what is meant by search object in these claims, since it is not a term in the art and is not defined in the Specification. In the interest of compact prosecution, it is taken to mean any entity that might be used to initiate a search and/or any entity that might be the target object of a search, as needed.

Claims 1-6 and 9-24 are rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential structural cooperative relationships of

elements, such omission amounting to a gap between the necessary structural connections. See MPEP § 2172.01.

The omitted structural cooperative relationships are: any relationship between search object and the highlighted groups of characters. As noted above, the Brief states that there may not be any, and in that case the role of the search object in the claims is unexplained, simply one of a list of unconnected elements.

Applicant's arguments with respect to claims 1-61 have been considered but are moot in view of the new ground(s) of rejection.

Claims 1, 3-7, 9-12, 14-33 and 35-45 are rejected under 35 U.S.C. 102(e) as being anticipated by Kleinberg, US 6,112,202, 29 August 2000.

Kleinberg is directed to a method of searching for information in a network, particularly in hyperlinked environments such as the Web [COL 1 lines 8-15]. While the invention is primarily discussed as a method, it is supported by an apparatus that includes appropriate means for executing the method [COL 5 lines 26-33], and may be embodied as a computer program product [COL 5 lines 34-40].

**As to claim 20:**

A system for receiving selection of one or more groups of characters in a document currently displayed to a user in response to the one or more groups of

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characters in the document being highlighted and a search object being selected while the one or more groups of characters in the document are highlighted;

One object of Kleinberg is to search for resources such as Web pages that are linked with hyperlinks [COL 4 lines 11-16]. Kleinberg is an improvement on the background technology in which hyperlinks may be highlighted [COL 2 line 49 to COL 3 line 4]. A set of highlighted words, pictures or icons associated with hyperlinks corresponds to a search object that initiates a search [COL 2 lines 51-56]. So does a hyperlink embedded in a displayed and/or highlighted item such as a word, phrase, icon or picture [COL 1 lines 61-67].

means for generating a search query using the selected one or more words; Kleinberg is directed to finding an initial set of P pages containing a query string, and then iterating the search to other pages linked to the set of P pages. This may be initiated by finding at least one page of interest [COL 4 lines 44-52; COL 7 lines 27-30], which corresponds to following any highlighted hyperlink on a Web page. Clicking on such a highlighted hyperlink corresponds to generating a search query for at least one page.

means for obtaining search results based on the search query; and

means for providing the search results to the user.

Returning one or more pages [FIG 1] corresponds to obtaining search results, and they may be displayed [COL 3 lines 13-18].

As to claim 21, the method of Kleinberg iterates the process to find linked pages [COL 4 lines 53-65], where pages are documents.

As to claim 25, determination of the start set (initial set of pages) in Kleinberg [COL 4 line 44] corresponds to prefetching documents associated with a search. Kleinberg counts links and determines scores for each stage of iteration [COL 4 lines 53-65]. As to claim 26, Web pages are documents and vice versa. As to claim 27, the hyperlinks on a Web page correspond to a list of links. As to claims 28 and 29, the iteration procedure of Kleinberg grows the set of pages returned [FIG 1] by finding documents linked to those already returned [COL 8 line 42 and after], which includes providing a prefetched document already found and providing one not yet found. As to claim 30, following the links to a Web page corresponds to doing an address lookup.

As to claims 35 and 36, the computation of hubs corresponds to determining the popularity of a linked document [COL 6 lines 30-49].

As to claim 41, the method of Kleinberg may limit the retrieved documents by returning only the k largest scores [FIG 1], which correspond to using a threshold.

As to claim 42, the iteration module of Kleinberg corresponds to a browser assistant.

As to claims 5-7, Kleinberg is an improvement on the practice of using phrases as hyperlinks [COL 1 line 38; line 63; COL 2 line 64].

As to claim 9, a paragraph is merely an extended phrase, for which the dictionary meaning includes: a sequence of words expressed as a unit. A phrase may also be an entire document.

As to claim 10, words and phrases correspond to textual concepts.

As to claim 11, Kleinberg applies a vector space model [COL 8 line 43 and after].

The elements of claims 1, 3-4, 12, 14-19, 22-24 and 31-33, 37-40 and 43-45 are rejected in the analysis above and these claims are rejected on that basis.

Claim 2, 8, 13 and 34 and 46-61 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kleinberg, US 6,112,202, 29 August 2000.

As to claims 8 and 13, Kleinberg does not address discarding words, particularly stop words, that are unnecessary for obtaining relevant results, but it would have been obvious for one of ordinary skill in the art at the time of the invention to do so because it is more efficient to omit unnecessary words.

As to claim 2, Kleinberg does not explicitly provide for a search object within a menu or toolbar. Official Notice is taken that it was well known at the time of the invention to provide a menu containing a list of the hyperlinks to most-recently visited Web sites within the toolbar of a browser. It would have been obvious to use such hyperlinks to initiate a search because the linked pages are have a high probability of content of interest and thus may be used to initiate a search in Kleinberg [COL 4 lines 30-33].

As to claim 34, Kleinberg does not explicitly apply click through rates. Official Notice is taken that the click through rate was a well-known measure of user interest at the time of the invention. Evidence for this is given by Wu et al, US 6,741,967 Table B COL 19], where such a rate is used as a measure of usability for advertisements.

The Specification of this application also teaches that it was well known in the art at the time of the invention [[page 17 line 15 to page 18 line 3].

It would have been obvious to one of ordinary skill in the art at the time of the invention to apply click-through rate to score documents because it is a useful measure of user interest.

As to claim 46, the list of most-recently visited Web sites corresponds to adding links to the Web page document being displayed. As to claims 47-48, such a visited

page is a publication and a name, and includes a link associated with the name. As to claim 49, in cases where the link is to a commercial Web site, it links to related documents associated with producers, sellers, reviewers and the like.

The elements of claims 50-61 are rejected in the analysis above and these claims are rejected on that basis.

#### **(10) Response to Argument**

The Applicant disagrees with the office action, mailed February 21, 2006, regarding the 112 1<sup>st</sup> paragraph rejection on pages 2-3. Namely, the 112 1<sup>st</sup> paragraph rejection regarding the phrase: "search object", which is not defined in the specification, and its relationship to highlighted characters is not set forth in an enabling manner. The Applicant went to a great length to explain how a user may activate a web browser, the user may then provide a URL of a document, the browser may use the address or query to obtain a document, the browser may display the document to the user, the user may perform a search. To perform the search, the user may select a word, phrase or paragraph in the document, by clicking to highlight the word or phrase or paragraph, or selecting a software button or menu item provided by a browser assistant. The browser assistant may detect selection of a word, a phrase, a paragraph, or an entire document in response to the user invoking functionality of the browser assistant. The browser assistant 330 may generate a search query based on one or more search terms from the selected word, phrase, paragraph, or document. The browser assistant may

generate a request to query the search engine using the search query and send the request to the search engine. In response to the request, the search engine may generate data that contains the search results and send the search results to the browser assistant, which may in turn present the results to the user. However, the Examiner respectfully submits that all these explanations do not amount or do not prove that the specification disclose "search object" and its relationship to highlighted characters in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

The Applicant disagrees with the office action, mailed February 21, 2006, regarding the 112 2<sup>nd</sup> paragraph rejection. Namely, It is not clear by what is meant by the term search object in these claims, since it is not a term in the art and is not defined in the Specification. The Applicant went to a great length to explain, as previously done before, without really come to a clear conclusion as to what is meant by the term search object. Also, the Applicant disagrees with the office action, mailed February 21, 2006, regarding the 112 2<sup>nd</sup> paragraph rejection. Namely, the claims being incomplete for omitting essential structural cooperative relationships of elements; the omitted structural cooperative relationships are: any relationship between search object and the highlighted groups of characters. Further, the Applicant concluded that the phrase "search object" is clear, when that phrase is properly interpreted in lights of the specification. In response to the aforementioned argument, the Examiner respectfully submits that although the claims are interpreted in light of the specification, limitations

from the specification cannot be read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

The Applicant argued, "Kleinberg does not disclose or suggest obtaining selection of one or more groups of characters in a document currently accessed by a user, where the obtaining includes highlighting the one or more groups of characters in the document and selecting a search object while the one or more groups of characters are highlighted in the document". However, the Examiner disagrees with this line of argument because Kleinberg specifically provides a methodology for "searching for desired items from a network of information resources" (See Kleinberg Abstract). In this case the information resources can be any document stored in the network; including web pages or groups or sets of web pages. In Kleinberg, an initial set of web pages is selected based on a conventional keyword-based query (See Kleinberg Abstract). In this case, the set of retrieved web pages represents a document in itself. Further, Kleinberg discloses, based on the resulted set of web pages, further selection of pages in the resulted set of web pages is achieved (See Kleinberg Abstract). From the explanation above, it is clear that the aspects of querying for document and selecting one or more group of characters in a retrieved document is achieved by Kleinberg; as to the aspect of selecting a search object, since the search object is not well defined in the specification, it is not clear as to what is meant by a search object. However, for Kleinberg, when a page is selected from the resulted set of pages, the source code being the selected page is configured to permit a link, previously set up,

which allows the pointed or highlighted page to be retrieved; thus, represent a search module.

The Applicant also argued, "claim 3 recites that the obtaining selection includes receiving selection of a single group of characters in the document. Kleinberg does not disclose or suggest this feature. The Office Action does not address the feature recited in claim 3. Accordingly, a proper case of anticipation has not been established with respect to claim 3. Moreover, since Kleinberg does not disclose or suggest obtaining selection of one or more groups of characters in a document currently accessed by a user, Kleinberg cannot disclose or suggest the above feature of claim 3". The Examiner respectfully submits that claim 3's feature of "receiving selection of a single group of character in the document" is achieve as a resulted set of web pages that are further selected from the resulted set of web pages (See Kleinberg Abstract). In this case a single page by itself is a single group of character in the document (the set of retrieved web pages represents a document in itself).

The Applicant further argued, that none of the features in claims 4-61 were addressed by the Office Action; However, the Examiner disagrees because the Office Action was submitted as follows:

Claims 1, 3-7, 9-12, 14-33 and 35-45 are rejected under 35 U.S.C. 102(e) as being anticipated by Kleinberg, US 6,112,202, 29 August 2000.

Kleinberg is directed to a method of searching for information in a network, particularly in hyperlinked environments such as the Web [COL 1 lines 8-15]. While the invention is primarily discussed as a method, it is supported by an apparatus that includes appropriate means for executing the method [COL 5 lines 26-33], and may be embodied as a computer program product [COL 5 lines 34-40].

**As to claim 20:**

A system for receiving selection of one or more groups of characters in a document currently displayed to a user in response to the one or more groups of characters in the document being highlighted and a search object being selected while the one or more groups of characters in the document are highlighted;

One object of Kleinberg is to search for resources such as Web pages that are linked with hyperlinks [COL 4 lines 11-16]. Kleinberg is an improvement on the background technology in which hyperlinks may be highlighted [COL 2 line 49 to COL 3 line 4]. A set of highlighted words, pictures or icons associated with hyperlinks corresponds to a search object that initiates a search [COL 2 lines 51-56]. So does a hyperlink embedded in a displayed and/or highlighted item such as a word, phrase, icon or picture [COL 1 lines 61-67].

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The elements of claims 50-61 are rejected in the analysis above and these claims are rejected on that basis.

From the above, It is clear for the record that all the limitations of all the claims were addressed or being referred to rejection of previously rejected claims.

**(11) Related Proceeding(s) Appendix**

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No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

*Frantz Coby*  
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PRIMARY EXAMINER

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